

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 16-17 and 22-27 are currently pending in this application. No new matter has been added by way of the present amendment.

In view of the amendments and remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 102(b)

Claims 16-17, 22 and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hakuta (WO 01/98407 and its U.S. equivalent, U.S. 6,743,862) (hereinafter Hakuta '407). Applicants respectfully traverse.

The Examiner asserts that Hakuta '407 discloses a method of preparing molded products made of various rubber compositions comprising presently claimed components (A), (C), (D) and (E). The Examiner further asserts that presently claimed component "B" is not required. Furthermore, the Examiner affirms that the composition disclosed by Hakuta '407 is liquid injection molded.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation. For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence

"must make clear that the missing descriptive matter is necessarily present". *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.*

Independent claims 16 and 17 are directed to a method for making a sealing or gasket material comprising the steps of kneading, molding and crosslinking a rubber composition, wherein the rubber composition comprises an organopolysiloxane (B) having a specific formula. Hakuta '407 fails to implicitly or explicitly disclose a composition as claimed.

Hakuta '407 discloses a crosslinkable rubber composition comprising an ethylene/ α -olefin/non-conjugated polyene random copolymer rubber, a SiH group-containing compound having at least two SiH groups in one molecule, a catalyst, and a reaction inhibitor.

However, Hakuta '407 fails to teach the presently claimed organopolysiloxane (B), having an average composition formula of $R^1_tSiO_{(4-t)/2}$, wherein R^1 is an unsubstituted or substituted monovalent hydrocarbon group and t is a number ranging from 1.9 to 2.1.

Additionally, Applicants respectfully submit that Hakuta '407 does not teach or suggest a method for making a sealing or gasket material for a fuel cell seal or a top cover gasket for a hard disk driver by molding a rubber composition into a molded product with the use of **liquid injection molding** (emphasis added), wherein the rubber composition comprises a copolymer rubber (A) and an organopolysiloxane (B).

Hakuta '407 does not teach or suggest that the SiH group-containing compound (B) is in the liquid state. Furthermore, Hakata '407 teaches that the random copolymer rubber (A) is in the solid state (see "Examples"). As is known in the art, liquid injection molding requires two

liquid components, as described at page 54, line 18 to page 55, line 19 of the present specification, a portion of which is reproduced below.

"When the rubber composition for fuel cell seals or HDD top cover gaskets is subjected to LIM, it is desirable to prepare liquid rubber compositions in which the SiH group-containing compound [C] and the catalyst [D] are separately contained."

The present inventors have discovered unexpected advantages by using liquid injection molding to mold a rubber composition comprising a copolymer rubber (A) possessing a specific range of intrinsic viscosity (0.01 to less than 0.3 dl/g), where the copolymer rubber (A) remains in the liquid state, and is further combined with a specific organopolysiloxane (B).

Clearly, Hakuta '407 fails to explicitly or implicitly teach each and every aspect of the present invention, and thus fails to anticipate the same.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claims 16-17 and 22-27

Claims 16-17 and 22-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakuta (WO 00/55251 and its U.S. equivalent, U.S. 6,864,315) (hereinafter Hakuta '251). Applicants respectfully traverse.

Initially, Applicants note that the Examiner asserts that "[t]he rejection of Claims 16-17 and 22-27 under 35 USC 102(b) as being unpatentable over Hakuta251...is maintained" (outstanding Office Action, page 4, paragraph 4). However, this appears to be a typographical error, as these claims had been rejected under 35 U.S.C. §103(a) previously (see Office Action of January 19, 2007 at page 4, paragraph 5).

The Examiner had previously asserted that Hakuta '251 discloses a method of preparing molded products made of various rubber compositions which could be kneaded, crosslinked and injection molded. In the Office Action of January 19, 2007 which rejection the Examiner repeats, the Examiner had acknowledged that Hakuta '251 "is silent on the specified claimed intrinsic viscosity", but asserted that it would be obvious to one skilled in the art to utilize a copolymer (A) having the claimed intrinsic viscosity "in order to afford a composition with a desired viscosity with expected success". In the outstanding Office Action, the Examiner asserts that Hakuta '251 teaches an intrinsic viscosity "that is very close to the claimed value", and further teaches that "a decrease in the viscosity of a composition is desirable".

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere

conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Contrary to the Examiner's assertion, Hakuta '251 does not teach or suggest a method for making a sealing or gasket material for a fuel cell seal or a top cover gasket for a hard disk driver by molding a rubber composition into a molded product with the use of **liquid injection molding** (emphasis added).

As previously discussed, it is well known in the art that liquid injection molding is conducted by using two liquid components. Hakuta '251 does not teach or suggest that the components are in the liquid state.

Claim 4 of Hakuta '251 clearly defines that the ethylene/ α -olefin/non-conjugated polyene random copolymer rubber (A) has an intrinsic viscosity (η) as measured in decalin at 135°C in the range of 0.3 to 10 dl/g. Hakuta '251 does not teach or suggest a copolymer rubber (A) having an intrinsic viscosity (η) lower than 0.3 dl/g. As is known in the art, a copolymer rubber having an intrinsic viscosity lower than 0.3 dg/l is in the liquid state. However, when the intrinsic viscosity exceeds 0.30 dl/g, the liquid viscosity rises suddenly and the copolymer rubber becomes a starch syrup and cannot be handled as a liquid.

Furthermore, the working examples of Hakuta '251 also exemplify that the copolymer rubber (A) and the resultant rubber composition are kneaded in the melt state or nearly melt state under heating and the rubber is further subjected to extrusion molding, injection molding or press molding. Clearly, Hakuta's copolymer rubber (A) is not in the liquid state.

The Examiner asserts that Hakuta '251 "teaches that in general a decrease in the viscosity of a composition is desirable". The Examiner asserts that this teaching is found at column 2, lines 24-37 of Hakuta '251. Applicants respectfully disagree.

The cited passage of Hakuta '251 describes the addition of reinforcements and fillers used to increase product hardness. When a rubber product is molded by extrusion molding or injection molding in the melt or nearly melt state under heating conditions, the compounding of the reinforcements or fillers impairs processability and increases the viscosity of the rubber product. Thus, techniques to decrease the viscosity of the compounded rubber product are employed, so as to maintain the processability of the rubber composition. Clearly, Hakuta '251 merely describes the technique of lowering the viscosity of a rubber product in the solid state at room temperature in order to be mold said product by extrusion molding or injection molding.

Evidently, the cited reference fails to teach or suggest every limitation of the instant invention. Furthermore, one skilled in the art would not be motivated to modify this reference. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claims 23 and 25

Claims 23 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakuta '407 optionally in view of Hakuta '251. Applicants respectfully traverse.

As discussed above, Hakuta '407 and Hakuta '251, alone or in combination, fail to teach or suggest a method for making a sealing or gasket material for a fuel cell seal or a top cover gasket for a hard disk driver by molding a rubber composition into a molded product with the use

of liquid injection molding, wherein the rubber composition comprises a copolymer (A) of specific properties and an organopolysiloxane (B).

Furthermore, one skilled in the art would not be motivated to modify the cited references or to combine reference teachings.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claims 26 and 27

Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakuta '407 in view of Hakuta '251. Applicants respectfully traverse.

As previously discussed, Hakuta '407 and Hakuta '251, alone or in combination, fail to teach or suggest a method for making a sealing or gasket material for a fuel cell seal or a top cover gasket for a hard disk driver by molding a rubber composition into a molded product with the use of liquid injection molding, wherein the rubber composition comprises a copolymer (A) of specific properties and an organopolysiloxane (B).

Furthermore, one skilled in the art would not be motivated to modify the cited references or to combine reference teachings.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

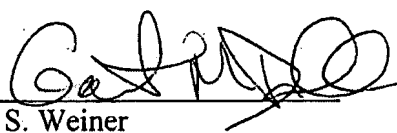
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Marc S. Weiner, Reg. No. 32,181 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: September 26, 2007

Respectfully submitted,

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